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JUL 27 2010

OFFICE OF PETITIONS

In re Application of :
Dukmans et al. : ON APPLICATION FOR
Application No. 10/055,388 : PATENT TERM ADJUSTMENT
Filed: January 23, 2002 :
For: FRONT END AND HIGH :
FREQUENCY RECEIVER HAVING :
QUADRATURE LOW NOISE AMPLIFIER :

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(b)" filed February 23, 2010. Applicants request that the determination of patent term adjustment be corrected from sixty (60) days to seven hundred fifty (750) days.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is DISMISSED as PREMATURE.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the

actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

To the extent that applicant otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is GRANTED to the extent indicated herein.

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

On November 23, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 60 days. The instant application for patent term adjustment was timely filed on February 23, 2010.

Applicants dispute the 530 day reduction and instead contend that a 470 day reduction is required. Petitioner contends the 470 day reduction is based upon the day the application was held abandoned on November 30, 2006 until the date the petition under 37 CFR 1.137(b) was granted on March 17, 2008.

A review of the application history confirms the reduction of 530 days is not warranted for the abandonment of the application pursuant to 37 CFR § 1.704(c)(3)(i) is required. Instead, a reduction of 563 days is required.

37 CFR 1.704(c) provides that:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

- (3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:
- (i) The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or
 - (ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed.

In this instance the application was held abandoned on September 1, 2006 based upon the failure of applicant to file a response to the final Office action of May 31, 2006. A timely request for extension of time was not provided. A grantable petition to revive under 37 CFR 1.137(b) was filed on February 12, 2008 and granted on March 17, 2008.

In accordance with 37 CFR 1.704(c)(3), the adjustment is properly reduced 563 days. The period of reduction commenced September 1, 2006, the date of abandonment, and ended March 17, 2008, the date of mailing of the decision reviving the application. See, 37 CFR 1.704(c)(3)(i).

However, further review of the record shows that a reduction of 82 days is warranted pursuant to 37 CFR 1.704(c)(10), for the submission of the request for continued examination (RCE) and Information Disclosure Statement (IDS) on September 3, 2009 after the mailing of the Notice of Allowance on May 29, 2009.

37 CFR 1.704 (c)(10) provides:

(10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

ii) Four months;

The submission of the RCE and IDS on September 3, 2009 after the mailing of the Notice of Allowance on May 29, 2009 constituted a failure to engage pursuant to 37 CFR 1.704 (c)(10). This period is 82 days, counting the number of days in the period beginning on September 3, 2009 and ending on November 23, 2009, the date of the mailing of the notice in response the amendment.

Applicants' delay total is 683 (3 + 563 + 30 + 5 + 82) days.

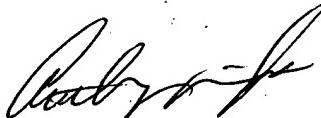
In view thereof, the correct determination of PTA at the time of the mailing of the notice of allowance is zero (0) days.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and **must** include payment of the required fee under 37 CFR 1.18(e).

There is no indication that the petition is signed by a registered patent attorney or patent agent of record. However, in accordance with 37 CFR 1.34, the signature of Mr. McCuthceon appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. If, Mr. McCuthceon desires to receive correspondence regarding this file, the appropriate power of attorney documents must be submitted. A courtesy copy of this decision is being mailed to Mr. McCuthceon, the petitioner herein. However, until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Charlema Grant at (571) 272-3215.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of REVISED PALM Screen

cc: Robert D McCuthceon
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PALM INTRANET

PTA Calculations for Application: 10/055388

Application Filing Date:	01/23/2002	PTO Delay (PTO):	628
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	568
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	-115		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
111	07/25/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		115	
101	11/23/2009	MAIL NOTICE OF ALLOWANCE			
100	11/18/2009	ISSUE REVISION COMPLETED			
99	11/18/2009	DOCUMENT VERIFICATION			
98	11/18/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
97	09/03/2009	REFERENCE CAPTURE ON IDS			
96	09/03/2009	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
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94	09/03/2009	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
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91	09/10/2009	DISPOSAL FOR A RCE / CPA / R129			
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89	09/03/2009	WORKFLOW - REQUEST FOR RCE - BEGIN			
88	06/29/2009	FINISHED INITIAL DATA CAPTURE			
87	06/01/2009	EXPORT TO INITIAL DATA CAPTURE			
86	05/29/2009	ELECTRONIC REVIEW			
85	05/29/2009	EMAIL NOTIFICATION			
84	05/29/2009	MAIL NOTICE OF ALLOWANCE			
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82	05/15/2009	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
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80	05/15/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
79	05/15/2009	CASE DOCKETED TO EXAMINER IN GAU			
78	05/13/2009	NOTICE OF ALLOWABILITY			
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70	01/22/2009	MAIL FINAL REJECTION (PTOL - 326)			
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45	03/14/2008	PETITION TO REVIVE APPLICATION - GRANTED			
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39	09/11/2007	MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
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11.7	07/16/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
11	07/16/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
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8	01/23/2002	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
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6	04/05/2002	APPLICATION IS NOW COMPLETE			

5	03/29/2002	ADDITIONAL APPLICATION FILING FEES		
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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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